UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

No. 09-56675

JAMES "JIM" BROWN,

Plaintiff/Appellant,

vs.

ELECTRONIC ARTS INC.,

Defendant/Appellee.

On Appeal from the United States District Court
for the Central District of California
No. 2:09-CV-01598-FMC-RZ
The Honorable Florence-Marie Cooper

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CORPORATE DISCLOSURE STATEMENT

Defendant/appellee Electronic Arts Inc. ("EA"), a nongovernmental corporate party, provides the following statement to comply with Federal Rule of Appellate Procedure 26.1:

EA has no parent corporation or publicly held corporation owning 10% or more of its shares.

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1.

SUMMARY OF ARGUMENT

This appeal presents one basic question: under the *Rogers* test,[1] does the First Amendment bar Jim Brown's Lanham Act claim against EA?

Much of Brown's Opening Brief has not bearing on that question. Tacitly acknowledging that his claim cannot survive the *Rogers* test, Brown resorts to two tactics. First, he relies heavily on Lanham Act cases that involve the use of a celebrity's name or likeness in a commercial advertisement or promotion.[2] But those cases have no application here, because EA's *Madden NFL* video game is an "expressive work[] entitled to as much First Amendment protection as the most profound literature."[3] Second, Brown urges this Court to replace the *Rogers* test

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[1] *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

[2] *See, e.g., Dryer v. National Football League*, 689 F. Supp. 2d 1113, 1121 (D. Minn. 2010) (Lanham Act claim targeting use of plaintiff's image in promotional videos that court treated as "commercial speech"); *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1002 (9th Cir. 2001) (use of plaintiff's likeness in clothing catalog); *Wendt v. Host Int'l*, 125 F.3d 806, 812 (9th Cir. 1997) (alleged use of plaintiffs' likenesses as promotional items in airport bars); *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407, 412 (9th Cir. 1996) (use of plaintiff's name in television commercial for automobile); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992) (use of plaintiff's voice in radio commercial for snack product); *White v. Samsung Electronics America*, 971 F.2d 1395, 1400 (9th Cir. 1992) (use of robot allegedly evoking plaintiff in television commercial for consumer electronics).

[3] ER 5, quoting *Kirby v. Sega of America*, 144 Cal. App. 4th 47, 58 (2006).

with either a likelihood-of-confusion test or an alternative-means test. This Court, however, specifically has rejected the likelihood-of-confusion test in Lanham Act cases that involve expressive works, explaining that it "fails to account for the full weight of the public's interest in free expression." *Mattel v. MCA Records*, 296 F.3d 894, 900 (9th Cir. 2002) ("*MCA Records*"). The alternative-means test also has been widely discredited because it, too, does "not sufficiently accommodate the public's interest in free expression." *Rogers*, 875 F.2d at 999.[4]

Despite Brown's efforts to obscure the question before this Court, there is no doubt that *Rogers* provides the controlling test to determine whether the First Amendment bars Brown's Lanham Act claim. In *MCA Records*, this Court expressly "agree[d] with … and adopt[ed]" the *Rogers* test "as [its] own," 296 F.3d at 902; and in a subsequent video-game case, *E.S.S. Entertainment 2000 v. Rock Star Videos*, 547 F.3d 1095, 1099-1101 (9th Cir. 2008), the Court extended the test to cover any use of a mark in an expressive work. Under the *Rogers* test, a defendant's use of an individual's name or likeness in an expressive work is constitutionally protected against a Lanham Act claim unless the use has "no artistic relevance to the underlying work whatsoever," or the use "explicitly

[4] *See also ETW Corp. v. Jireh Publ'g*, 332 F.3d 915, 927 (6th Cir. 2003) (rejecting alternative-means test); *Parks v. LaFace Records*, 329 F.3d 437, 449-450 (6th Cir. 2003) (same); *Westchester Media v. PRL Holding USA*, 214 F.3d 658, 672 (5th Cir. 2000) (same); *L.L. Bean, Inc. v. Drake Publishers*, 811 F.2d 26, 29 (1st Cir. 1987) (same).

misleads" consumers into believing that the plaintiff endorsed the work. *MCA Records*, 296 F.3d at 902; *Mattel v. Walking Mountain Productions*, 353 F.3d 792, 807 (9th Cir. 2003) ("*Walking Mountain*"); *E.S.S.*, 547 F.3d at 1099. The district court properly applied the *Rogers* test to dismiss Brown's Lanham Act claim.

Remarkably, Brown never addressed the *Rogers* test below.[5] Now, on appeal, he misstates and misapplies it. He tries to replace the test's first prong with a more subjective "artistic relatedness" standard that would protect only "parody, satire, or critical commentary." Op. Br. at 34. This Court made clear in *MCA Records* and in *E.S.S.*, however, that a defendant satisfies the first prong of the *Rogers* test simply by showing that its use of the plaintiff's likeness has some relevance to its expressive work. *MCA Records*, 296 F.3d at 900; *E.S.S.*, 547 F.3d at 1098, 1100. "In other words, the level of relevance merely must be above zero." *E.S.S.*, 547 F.3d at 1100. A review of the content of EA's video game, which was before the district court under the "incorporation by reference" doctrine and is part of the record on appeal,[6] confirms the district court's determination that EA's alleged use of Brown's "likeness in a game about NFL football is clearly relevant."[7]

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[5] ER 211-214.

[6] ER 2 n.1.

[7] ER 8.

Turning to the second prong of the *Rogers* test, Brown contends that the district court erred by concluding that EA's alleged use of his likeness did "not constitute an *explicit* attempt to convince consumers that Brown endorsed the games."[8] Citing extensively to a treatise's discussion of a 27-year-old consumer survey about the use of cartoon characters on apparel, Brown insists that EA's alleged use of his likeness in the game – *by itself* – is sufficient to create a factual issue as to whether EA explicitly misled consumers. *See* Op. Br. at 1, 18, 24, 25, 31, 36, 37, 39, 46, citing 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 10:43, at 10-120 (4th ed. 2010) ("McCarthy"). *MCA Records* and *E.S.S.* unequivocally refute this argument. *MCA Records*, 296 F.3d at 902; *E.S.S.*, 547 F.3d at 1100-1101. As the district court held, "[m]ere inclusion of a celebrity's likeness in the work is insufficient to satisfy the second prong of *Rogers*." ER 1:1:9, citing *E.S.S.*, 547 F.3d at 1100.

Brown's other arguments on this second prong are similarly unpersuasive, and do not come close to meeting the *explicitly*-misleading standard. He points to an instruction manual from *Madden NFL 2001* (an edition first released in 2000 and not at issue in this action), which states that the game includes "[f]ifty of the NFL's greatest players[.]" Op. Br. at 6, 37. But if the alleged use of Brown's likeness in the game itself is insufficient to satisfy the second prong, then an (at

[8] ER 9 (emphasis in original).

most) implied assertion that the game includes his likeness cannot be sufficient either. Brown also argues that EA allegedly "scrambled" his likeness in the relevant editions of *Madden NFL* by changing his jersey number, and thereby explicitly misled consumers into believing that he endorsed the game. Op. Br. at 7, 9, 37, 38. The district court accurately observed that, even if true, such a change would reinforce the perception that Brown was *not* associated with the game.[9] Finally, Brown complains that EA allegedly told "his representatives" that certain editions of the game did not include his name or likeness, and that an EA representative allegedly told a law-school panel that EA had "obtained the authorization" to use some other, unidentified players' likenesses in the game. Op. Br. at 37-38. Even assuming the truth of those allegations, they do not remotely qualify as *explicit* attempts to mislead consumers into believing that Brown endorsed *Madden NFL* (and, as discussed below, the statements are not even misleading). *See* Section 7.C.2.

As the district court found, Brown did not – and cannot – allege any facts showing that EA explicitly misled consumers into believing that Brown sponsored the game.[10] To the contrary, "it would require a leap of logic to conclude that the anonymous, mis-numbered player's presence in the games equates to Brown's

[9] ER 9.

[10] ER 8.

endorsement of the games."[11] Consequently, the district court properly held that the First Amendment defeats Brown's Lanham Act claim.

Brown and his counsel plainly believe that this Court erred in *MCA Records*, *Walking Mountain*, and *E.S.S.*, and want the Court to roll back constitutional protections for the creators of expressive works that incorporate the names or likenesses of real-life individuals. This Court should decline to do so, and should affirm the district court's order dismissing Brown's Lanham Act claim without leave to amend.

2.

STATEMENT OF JURISDICTION

This action arises under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), California Civil Code Section 3344, the California common-law right of publicity, and California Business and Professions Code Section 17200. The district court had jurisdiction under 28 U.S.C. §§ 1331, 1338(a), and 1367. This Court has jurisdiction under 28 U.S.C. § 1291.

[11] ER 9.

3.

STATEMENT OF ISSUE

Did the district court properly dismiss Brown's Section 43(a) claim on the grounds that the First Amendment protects EA's alleged use of Brown's likeness in its *Madden NFL* video game?[12]

4.

STATEMENT OF THE CASE

Brown filed a complaint in the Central District of California alleging four causes of action against EA arising from its alleged use of his likeness in EA's *Madden NFL* video game.[13] EA moved to dismiss each of Brown's claims, and to strike his state-law claims under California's anti-SLAPP statute.[14] On September 23, 2009, the district court granted EA's motion to dismiss Brown's Lanham Act claim, declined to exercise supplemental jurisdiction over his state-law claims, and denied EA's anti-SLAPP motion as moot.[15]

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[12] The text of pertinent constitutional provisions and statutes is set forth in an addendum to this brief.

[13] ER 11-26.

[14] ER 27-55, 56-83.

[15] ER 10.

5.

STATEMENT OF FACTS

A. EA's *Madden NFL* Video Game

Defendant-appellee Electronic Arts Inc. ("EA") is a leading developer and publisher of video games, including *Madden NFL*. EA has published an annual edition of *Madden NFL* each summer for more than twenty years.[16] Combining technically advanced computer and software engineering and highly creative audiovisual elements, the game allows users to experience the excitement and challenge of NFL football. Users may compete against an opponent controlled by the game itself, against a person connected to the same game system, or against a person connected over the Internet.[17]

The virtual world of *Madden NFL* is constructed from an array of video graphics, audio features, and data. After a user chooses two NFL teams to compete against each another, the video game assigns a stadium for the match-up and populates it with players, coaches, referees, cheerleaders, and fans – all designed and rendered by EA's graphic artists.[18] Users are not limited to the current year's NFL teams; some versions of *Madden NFL* also include historical teams, such as

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[16] ER 16, 95.

[17] ER 95-96, 107-114.

[18] ER 95-96, 107-114.

the 1965 Cleveland Browns and All-Browns teams that are the subject of Brown's complaint.[19] In total, those versions of the game allow users to choose from among approximately 170 teams with more than 1,500 virtual players.[20]

Although the virtual players' personal characteristics (such as height, weight, athletic ability, and experience) and other variables (including crowd noise and weather) affect the teams' performances, the individual users most directly influence the game's outcome through their play-calling and their ability to use hand-held controllers to manipulate the virtual players' actions on the field. In addition, users may alter the abilities, appearances, and biographical information of the virtual players already assigned to teams, or even create entirely new virtual players for their teams.[21]

The results of the game are presented audio-visually through real-time, television-like animation and action-specific, play-by-play commentary.[22] The games also include realistic original sounds, such as the crunch of players' pads as

[19] ER 96.

[20] ER 96, 107-114. *See also id.* 2.

[21] ER 97, 107-114.

[22] ER 96, 107-114.

contact is made, the audible of a quarterback changing a play at the line of scrimmage, and the roar of the crowd.[23]

The game offers users more than just the opportunity to simulate single games. They also can create and manage their own NFL franchises and assemble their own offensive and defensive playbooks.[24] In the game's Franchise Mode, users have the ability to control a team for several seasons, including drafting players and trading players with other teams.[25] In Superstar Mode, users assume responsibility for a rookie player's career, guiding him through interviews, IQ tests, and workouts with prospective teams, hiring an agent, and making decisions about other aspects of the athlete's life that may affect his on-the-field performance.[26]

B. Brown's Lawsuit

Plaintiff-appellant James "Jim" Brown played running back for the Cleveland Browns from 1957 to 1965.[27] In July 2008, he sued EA and Sony in the federal district court for the Southern District of New York, alleging Lanham Act,

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[23] ER 96, 107-114.

[24] ER 96, 107-114.

[25] ER 96, 107-114.

[26] ER 96.

[27] ER 13.

right-of-publicity, and related claims based on EA's alleged use of his likeness in the 1965 Cleveland Browns and All Browns teams that were included in certain editions of *Madden NFL*.[28] When presented with a draft 12(b)(6) motion, Brown voluntarily dismissed his New York action.[29]

EA presumed the matter was closed. But on March 6, 2009, Brown filed this action against EA in the Central District of California, claiming that EA's alleged use of his likeness in *Madden NFL* violated Section 43(a) of the Lanham Act, California Civil Code Section 3344, the California common-law right of publicity, and California Business & Professions Code Section 17200. By likeness, Brown refers only to his "physical stature," "running ability," "race," and "statistics."[30] Because of the applicable statutes of limitations on Brown's claims, only *Madden NFL '06*, *Madden NFL '07*, *Madden NFL '08*, and *Madden NFL '09* are at issue here.[31]

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[28] ER 135-148. Brown apparently sued Sony because it manufactured game consoles on which certain editions of *Madden NFL* can be played.

[29] ER 149-150.

[30] ER 16, 22. Brown does not allege that EA's game uses his name or actual likeness. *Id.* 15, 19, 20.

[31] ER 38-39.

C. EA's Motion To Dismiss

After Brown failed to oppose EA's initial motion to dismiss and anti-SLAPP motion, the district court granted those motions and gave Brown leave to amend.[32] On July 22, 2009, Brown filed an amended complaint – his third attempt at stating a claim against EA – setting forth the same four causes of action.[33] EA again moved to dismiss and moved to strike under the anti-SLAPP statute.[34] Although Brown did not attach copies of the game to his complaint, EA lodged the relevant annual editions of the game, a game console, and game controllers with the district court, and asked the court to take judicial notice of the game's contents.[35] Because Brown's claims "depend on the contents" of the game, and because there was no question about the authenticity of the editions of the game that EA submitted, the district court considered those editions under the "incorporation by reference" doctrine.[36]

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[32] Supplemental Excerpts of Record ("SER") 2.

[33] ER 11.

[34] ER 27, 56.

[35] ER 34 n.5, 63 n.5, 85.

[36] ER 2 n.1.

Having reviewed the contents of the game, the district court granted EA's motion and dismissed Brown's Lanham Act claim with prejudice.[37] For purposes of the motion, the court assumed that EA's game included Brown's likeness.[38] Applying the *Rogers* test, the court held that the use of Brown's likeness was "clearly relevant" to the game, and that EA did not explicitly mislead consumers into believing that Brown sponsored or endorsed the game.[39] Because Brown already had been given multiple opportunities to state a claim for relief, the district court dismissed the Lanham Act claim without leave to amend.[40] The court then declined to exercise jurisdiction over the remaining state-law claims, and denied the motion to strike as moot.[41]

6.

STANDARD OF REVIEW

A dismissal without leave to amend is reviewed de novo. *Kahle v. Gonzales*, 487 F.3d 697, 699 (9th Cir. 2007); *Knievel v. ESPN*, 393 F.3d 1068, 1072 (9th Cir. 2005). However, a district court's decision to deny leave to amend

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[37] ER 10.

[38] ER 5 n.2, 8 n.4.

[39] ER 8-9.

[40] ER 9-10.

[41] ER 9-10.

is entitled to much greater deference where, as here, the plaintiff previously has filed an amended complaint. *Miller v. Yokohama Tire Corp.*, 358 F.3d 616, 622 (9th Cir. 2004).

7.

THE DISTRICT COURT PROPERLY DISMISSED BROWN'S LANHAM ACT CLAIM WITHOUT LEAVE TO AMEND.

A. Because EA's Video Game Is Entitled To Full Constitutional Protection, The Commercial-Speech Cases That Brown Relies On Are Irrelevant.

Brown's argument to this Court is radical. He insists that his asserted right under the Lanham Act to control the use of his likeness is absolute, absent action "by the state, after appropriate administrative, legislative or judicial proceedings." Op. Br. at 24. His theory ignores not only this Court's authorities like *Mattel*, *Walking Mountain*, and *E.S.S.*, but also the fundamental rule that content-based restrictions on non-commercial speech trigger substantial First Amendment scrutiny. *See Glendale Associates v. NLRB*, 347 F.3d 1145, 1156 (9th Cir. 2003).

Recognizing this rule, the district court emphasized in its order that "it is important to establish the type of speech at issue [in this case]; the type of speech determines the appropriate First Amendment test. For example, non-commercial speech receives more robust constitutional protection."[42] The court then explained

[42] ER 5, citing *Hoffman v. Capital Cities/ABC Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2000).

that "[i]t is well established that 'video games are a form of expression protected by the First Amendment.'"[43] The district court was correct; video games are "expressive works that are entitled to as much First Amendment protection as the most profound literature." *Kirby*, 144 Cal. App. 4th at 58.[44]

Brown conspicuously fails to address the type of speech that is at issue in this appeal. But he implies, without expressly stating, that EA's game is commercial speech, and thus relies heavily on Lanham Act cases involving the alleged use of celebrities' likenesses in advertisements and promotions. For example, he devotes substantial attention to *Dryer*, which he points out also "involv[ed] the use of retired NFL player trademarks[.]" Op. Br. at 17. But Brown disregards a crucial legal distinction: the defendant's works in *Dryer* were

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[43] ER 5, citing *Video Software Dealers Ass'n v. Schwarzenegger*, 556 F. 3d 950, 958 (9th Cir. 2009) (observing that the State did "not contest that video games are a form of expression protected by the First Amendment"), *cert. granted*, 130 S. Ct. 2398 (U.S. Apr. 26, 2010).

[44] This Court and many others have recognized that video games enjoy the same constitutional protections as other expressive works. *See, e.g., E.S.S.*, 547 F.3d at 1098-1101; *Interactive Digital Software Ass'n v. St. Louis County*, 329 F.3d 954, 957 (8th Cir. 2003); *American Amusement Machine Ass'n v. Kendrick*, 244 F.3d 572, 577-579 (7th Cir. 2001); *Romantics v. Activision Publishing*, 574 F. Supp. 2d 758, 766 (E.D. Mich. 2008) (video games "are entitled to First Amendment protection"). That constitutional protection in no way is diminished by the fact that an expressive work is created for profit. *See, e.g., Time, Inc. v. Hill*, 385 U.S. 374, 381 (1967) ("[t]hat books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment") (citations omitted); *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501-502 (1952) (same).

"promotional videos" that the district court determined to be "commercial speech." *Id.* at 1119-1121. *Dryer* thus has no relevance to the current appeal, where EA's game indisputably is an expressive work.

Brown's reliance on a series of advertising cases from this Court likewise is misplaced. To support his contention that "this Court repeatedly has held that unauthorized commercial use of virtually any indicia of a celebrity's persona can mislead the public into believing that a celebrity endorsed a product or service" (Op. Br. at 21-22), Brown cites five cases: *Downing v. Abercrombie & Fitch*, 265 F.3d 994; *Wendt v. Host Int'l*, 125 F.3d 806; *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407; *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093; and *White v. Samsung Electronics America*, 971 F.2d 1395. Yet, as even Brown admits, *all* of those cases involve the use of an attribute of a celebrity's persona in pure commercial speech: a surfer's name and image in a clothing catalog, *Downing*, 265 F.3d at 1007; two actors' alleged likenesses to promote a chain of airport bars, *Wendt*, 125 F.3d at 812-814; a basketball star's original name in a television commercial for an automobile, *Abdul-Jabbar*, 85 F.3d at 412-413; an imitation of a singer's voice in a radio advertisement for a tortilla chip, *Waits*, 978 F.2d at 1106; and a robot that allegedly evoked a game-show host in a television advertisement for a VCR, *White*, 971 F.2d at 1397.

In contrast, Brown's Lanham Act claim arises from EA's alleged use of his likeness in a video game that is entitled to full constitutional protection. *Dryer* and this line of Ninth Circuit commercial-speech cases thus have no bearing on the First Amendment protections that apply to *Madden NFL*.

B. Neither The Likelihood-Of-Confusion Test Nor The Alternative-Means Test Applies Here.

Brown also tries to deflect EA's First Amendment protections by urging this Court to apply the likelihood-of-confusion test from *Dr. Seuss Enterprises v. Penguin Books USA*, 109 F.3d 1394 (9th Cir. 1997), or an amorphous alternative-means test that Brown traces to *International Olympics Committee v. San Francisco Arts & Athletics*, 781 F.2d 733 (9th Cir. 1986) ("*IOC*"), *aff'd on other grounds*, *San Francisco Arts & Athletics v. U.S. Olympic Committee*, 483 U.S. 522 (1987) ("*SFAA*"). Op. Br. at 41-45. These tests also are irrelevant.

1. The Likelihood-Of Confusion Test

Five years after *Dr. Seuss*, this Court rejected the likelihood-of-confusion test for Lanham Act claims that target expressive works. *MCA Records*, 296 F.3d at 900-902. The Court in *MCA Records* noted that "[o]ur likelihood-of-confusion test generally strikes a comfortable balance between the trademark owner's property rights and the public's expressive interests. But when a trademark owner asserts a right to control how we express ourselves[,] … *the traditional test fails to account for the full weight of the public's interest in free expression*." *Id.* at 900

(emphasis added; citations omitted). "The First Amendment may offer little protection for a competitor who labels its commercial good with a confusingly similar mark, but trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view." *Id.* (citations and internal quotation marks omitted). Because the likelihood-of-confusion test does not adequately protect free expression, the Court instead adopted the *Rogers* test, *id.*, and subsequently has applied it without exception to Lanham Act claims involving the use of a mark in an expressive work. *Walking Mountain*, 353 F.3d at 807; *E.S.S.*, 547 F.3d at 1098-1101.[45]

2. The Alternative-Means Test

The alternative-means test is even less protective of speech. In *Rogers*, the Second Circuit rejected the alternative-means test because it "does not sufficiently

[45] *See also ETW*, 332 F.3d at 926 (rejecting likelihood-of-confusion test for Lanham Act claim arising from use of Tiger Woods' name and likeness on lithographs and related packaging; holding that "where the defendant has articulated a colorable claim that the use of a celebrity's identity is protected by the First Amendment, the likelihood of confusion test is not appropriate because it fails to adequately consider the interests protected by the First Amendment"); *Parks*, 329 F.3d at 444 (rejecting likelihood-of-confusion test for Lanham Act claim arising from use of civil-rights pioneer's name in song title; noting that "the likelihood of confusion factors in trademark cases … give[s] no weight to First Amendment concerns. Instead, it treats the name of an artistic work as if it were no different from the name of an ordinary commercial product. However, this approach ignores the fact that the artistic work is not simply a commercial product but is also a means of communication").

accommodate the public's interest in free expression." 875 F.2d at 999. Even in the context of the use of a mark in the *title* of an expressive work, which implicates the Lanham Act's source-identification function more directly than does the mere use of a mark within an expressive work, the court observed that the "'no alternative' standard provides insufficient leeway for literary expression." *Id.*

The court in *Rogers* distinguished another alternative-means case that Brown cites, *Dallas Cowboy Cheerleaders v. Pussycat Cinemas*, 604 F.2d 200 (2d Cir. 1979). In *Rogers*, the Second Circuit narrowly circumscribed its earlier holding in *Dallas Cowboy Cheerleaders*, noting that that case involved a "movie with blatantly false advertising … stating that the principal actress in the movie was a former Dallas Cowboys' cheerleader." 894 F.2d at 999 n.4. The *Rogers* court concluded: "We do not read *Dallas Cowboys Cheerleaders* as generally precluding all consideration of First Amendment concerns whenever an allegedly infringing author has 'alternative avenues of communication.'" *Id.* Put simply, "the Second Circuit all but retracted its *Dallas Cowboys* decision in *Rogers*." *Parks*, 329 F.3d at 450.

The Sixth Circuit in *Parks* likewise "reject[ed] the alternative avenues test" because it does not "accord[] adequate weight to the First Amendment[.]" *Id.* at 448-450. The court explained that the test was "derived from real property law[,]" and "is premised on the notion that, just as a real property owner may exclude a

speaker from a shopping mall so long as other locations exist for the speaker to deliver his message, a celebrity may prohibit use of his or her name so long as alternative ways exist for the artist to communicate his or her idea." *Id.* at 449. But the Sixth Circuit made clear that "[t]o suggest that other words can be used as well to express an author's or composer's message is not a proper test for weighing First Amendment rights." *Id.* at 450.[46]

Nor does this Court's 24-year-old opinion in *IOC* support Brown's alternative-means argument. As a threshold matter, *IOC* turned on a specific statute, 36 U.S.C. § 380, that exempted the "Olympics" mark from defenses otherwise available under the Lanham Act. *IOC*, 781 F.2d at 736. *See also SFAA*, 483 U.S. at 526, 530. Brown enjoys no such statutory exemption here. Moreover, the Supreme Court noted that the statute at issue in *IOC* "applie[d] primarily to commercial speech." *SFAA*, 483 U.S. at 537 n.15. In contrast, Brown's claim targets EA's video game, which is an expressive work entitled to full First Amendment protection. *See* cases cited in fn. 44. Not surprisingly, this Court's

[46] *See also ETW*, 332 F.3d at 927 ("[w]e agree with the Second Circuit's conclusion that the 'no alternative means' test does not sufficiently accommodate the public's interest in free expression"); *Westchester Media*, 214 F.3d at 672 (criticizing alternative-means test; noting that it "bears a tenuous relation to communicative and property interests embodied in trademarks"); *L.L. Bean*, 811 F.2d at 29 (rejecting alternative-means test; "[t]he first amendment issues involved in this case cannot be disposed of by equating the rights of a trademark owner with the rights of an owner of real property").

IOC decision never has been cited with approval in a Lanham Act case arising from the use of a mark in an expressive work, and this Court's subsequent decisions in *MCA Records*, *Walking Mountain*, and *E.S.S.* make clear that the alternative-means test does not provide sufficient protection for free expression, and thus does not apply when evaluating a Lanham Act claim that challenges the use of a trademark within an expressive work.

Consequently, this Court summarily should reject Brown's proposed likelihood-of-confusion and alternative-means tests.

C. Applying The Rogers Test, The District Court Correctly Held That The First Amendment Bars Brown's Lanham Act Claim.

Despite Brown's efforts to blur the issues, this appeal turns on one question: did the district court properly apply the *Rogers* test to dispose of Brown's Lanham Act claim? The answer is "yes."

In *Rogers*, entertainer Ginger Rogers brought Lanham Act, right-of-publicity, and other claims against the producers of the film *Ginger and Fred* – a title that alluded to Rogers' collaboration with Fred Astaire. 875 F.2d at 996-997. The film was not about the iconic American performers, but about two fictional Italian cabaret singers who once earned their livings by imitating the real Ginger and Fred. *See id.* at 996-997. Addressing Rogers' Lanham Act claim, the court reasoned that "the expressive element of titles requires more protection than the labeling of ordinary commercial products." *Id.* at 998. "Because overextension of

Lanham Act restrictions in the area of titles might intrude on First Amendment values," the court held that "we must construe the Act narrowly to avoid such a conflict," and allow Lanham Act claims to proceed "only where the public interest in avoiding consumer confusion outweighs the public interest in free expression." *Id.* at 998-999. The court emphasized that this balance must favor the First Amendment "unless the title has *no artistic relevance to the underlying work whatsoever*, or, if it has some artistic relevance, unless the title *explicitly misleads* as to the source or the content of the work." *Id.* at 999 (emphases added). Applying this two-part test, the court dismissed Rogers' Lanham Act claim, explaining that even where the defendant uses a name or other mark in the title of an expressive work, "the slight risk that such use of a celebrity's name might *implicitly* suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression, and the Lanham Act is not applicable." *Rogers*, 875 F.2d at 999-1000 (emphasis added).

In *MCA Records*, this Court "agree[d] with the Second Circuit's analysis and adopt[ed] the *Roger*s standard as our own." 296 F.3d at 902. This Court reaffirmed that it had "adopted" the *Rogers* test in *Walking Mountain*. 353 F.3d at 807. Even more recently, this Court made clear that the *Rogers* test applies to *any* use of a mark *within* an expressive work – and, specifically, a video game. *E.S.S.*, 547 F.3d at 1098-1101. Calling the "intersection of trademark law and the First

Amendment" a "road ... well traveled," *id.* at 1098, this Court in *E.S.S.* reaffirmed that "[a]n artistic work's use of a trademark that otherwise would violate the Lanham Act is not actionable 'unless the [use of the mark] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless [it] explicitly misleads as to the source or the content of the work." *Id.* (quoting *MCA Records*, 296 F.3d at 902) (internal citation omitted).

As these cases demonstrate, *Rogers* provides the proper test for determining whether the First Amendment bars Brown's Lanham Act claim. Unless EA's alleged use of Brown's likeness has no artistic relevance to its game, or unless EA explicitly has misled consumers into believing that Brown sponsored or endorsed the game, then Brown's Lanham Act claim must be dismissed.[47] The district court correctly applied the *Rogers* test in dismissing Brown's Lanham Act claim.

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[47] Brown attempts to distinguish *Rogers* and *MCA Records* on the basis that they involve the use in a mark in a title of an expressive work, as opposed to within the work. Op. Br. at 27-31. This Court already has rejected that purported distinction, observing that "there is no principled reason why [the *Rogers* test] ought not also apply to the use of a trademark *in the body of the work*." *E.S.S.*, 547 F.3d at 1098 (emphasis added). *See also Romantics*, 574 F. Supp. 2d at 766 (applying *Rogers* test to claim based on use of plaintiffs' "distinctive sound" within the video game *Guitar Hero*). This conclusion makes sense; the use of the plaintiff's mark in a title ordinarily will be more prominent than a use of the mark within a work, and arguably might create a greater risk of consumer confusion. Using John Madden's name in the title of *Madden NFL*, for example, may suggest his endorsement of the game; merely using a player's alleged likeness within the game does not.

1. The Alleged Use of Appellant's Likeness Is Artistically Relevant to EA's Game.

Brown's three overlapping artistic-relevance arguments ignore this Court's controlling authority. First, relying on the Sixth Circuit's decision in *Parks* and a district court's decision in *American Dairy Queen Corp. v. New Line Productions*, 35 F. Supp. 2d 727 (D. Minn. 1998), he argues that a question of fact exists on this prong of the *Rogers* test. Op. Br. at 35. Both cases are easily distinguishable.

In *American Dairy Queen*, the district court applied the widely discredited alternative-means or "alternative avenues" test to preliminarily enjoin the defendant from using the title "Dairy Queens" for its documentary about beauty-pageant contestants in rural Minnesota. 35 F. Supp. 2d at 727-729, 733-735. Because, as discussed above, the alternative-means test does not adequately protect expression, it simply does not apply in this Circuit. *See* Section 7.B.2. Thus, *American Dairy Queen* has no bearing on this appeal.

Nor does *Parks* support Brown's argument. There, civil-rights pioneer Rosa Parks sued the rap group OutKast, alleging, among other things, that the song *Rosa Parks* violated her rights under Section 43(a) of the Lanham Act. 329 F.3d at 441. The defendants admitted that the song's content had nothing to do with Parks or the civil-rights movement generally; its "sole message is that [the defendants' musical] competitors are of lesser quality and, therefore, must 'move to the back of the bus,' or in other words, 'take a back seat'" to the defendants. *Id.* at 452-453.

Nonetheless, the defendants argued that the use of Parks' name in the title was "metaphorical[ly]" related to the song's refrain, in which they told their competitors to "move to the back of the bus." *Id.* at 452. The Sixth Circuit disagreed, concluding that a triable issue of fact existed as to whether the use of Parks' name in the title had even nominal artistic relevance to the content of the song. *Id.* at 458. The *Parks* court did not suggest any *per se* rule that this prong of the *Rogers* test ordinarily presented an issue of fact, and cited this Court's holding in *MCA Records* with approval. *Id.* at 451, 456.

Second, Brown mistakenly equates OutKast's admission in *Parks* that its song was not about Rosa Parks or the civil-rights movement with EA's alternative legal argument below that its game did not use any attribute of Brown's persona that is specifically protectable under the Lanham Act or under California's statutory or common-law right of publicity. Op. Br. at 34. EA's legal argument, however, was that even if various alleged attributes of Brown's persona, including his strength, speed, statistics, and race, were embodied in one of the virtual running backs on the 1965 Cleveland Browns team in *Madden NFL*, those attributes were not among the five statutorily enumerated attributes that are protected under California Civil Code Section 3344 or among those that courts have extended protection to under the common-law right of publicity or Section 43(a) of the

Lanham Act.[48] Unlike the defendants in *Parks*, who in fact denied that their song had any relation to the civil-rights movement or anything else associated with Rosa Parks, there is no dispute that *Madden NFL* is about NFL football. Brown's analogy between *Parks* and the present case thus misses the mark.[49]

Third, Brown argues that the district erred in granting EA's motion to dismiss because a "jury here could reasonably conclude that EA used Brown's persona not to make a parody, satire, or critical commentary relating to Brown, nor any other artistic comment[.]" But the first prong of the *Rogers* test does not ask whether the defendant's use of the plaintiff's likeness was for "parody, satire, or critical commentary" about the plaintiff, or for some "other artistic comment." Under *Rogers*, the use is constitutionally protected unless it "*has no artistic relevance to the underlying work whatsoever*." *MCA Records*, 296 F.3d at 902 (emphasis added), quoting *Rogers*, 875. F.2d at 999. As this Court explained in *E.S.S.*, "only the use of a trademark with no artistic relevance to the underlying work whatsoever does not merit First Amendment protection. … In other words, *the level of relevance merely must be above zero*." *Id.* at 1100 (emphasis added).

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[48] ER 39-41.

[49] In any event, the district court assumed for purposes of the motion to dismiss that the game incorporated Brown's actual likeness. ER 5 n.2, 8 n.4.

By asking only whether "the level of relevance [is] above zero," courts avoid highly subjective inquiries into the nature of creative works. *Cf. Bleinstein v. Donaldson Lothographing Co.*, 188 U.S. 239, 251 (1903) (Holmes, J.) ("[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits"). "Except in rare and extreme cases … courts should avoid as much as possible making the protections of the First Amendment turn on the courts' assessment of literary success." *Yankee Publ'g Inc. v. News America Publ'g Inc.*, 809 F. Supp. 267, 281 (S.D.N.Y. 1992).

Rogers is instructive. There, the Second Circuit affirmed the district court's conclusion "that the title 'Ginger and Fred' surpasses the minimum threshold of artistic relevance to the film's content." 875 F.2d at 1001. The court did not look to any evidence on this question – only to the content of the defendants' film. The court observed that the names "Ginger and Fred" "[we]re not arbitrarily chosen just to exploit the publicity value of their real life counterparts but instead have genuine relevance to the film's story." *Id.* According to the Second Circuit, this conclusion "[wa]s not subject to dispute." *Id.*

This Court similarly has resolved the "artistic relevance" test simply by looking at the defendant's work. In *MCA Records*, for example, this Court reviewed the lyrics to the song *Barbie Girl* and held that the defendant-band's use

of "Barbie" in the song's title easily satisfied the more-than-zero-artistic-relevance standard. 296 F.3d at 902. And in *Walking Mountain*, the Court held that the defendant's use of "Barbie" in the titles of an artist's photographs depicting the doll in highly provocative settings satisfied the artistic-relevance standard. 353 F.3d at 807.

Most recently, in *E.S.S.*, this Court addressed the artistic-relevance threshold in the context of a video-game publisher's use of the plaintiff's mark within a game. 547 F.3d at 1098-1101. There, the plaintiff, who operated a strip club called the "Play Pen" in East Los Angeles, sued the publisher of the video game *Grand Theft Auto: San Andreas*, which featured a virtual strip club called "the Pig Pen" located in a virtual neighborhood called "East Los Santos." 547 F.3d at 1097. The game's designers admittedly "took some inspiration" from photographs they had made of the real-world Play Pen, although the two establishments (one real, one virtual) were not identical in appearance. *Id.* at 1097-1098. With respect to the first prong of the *Rogers* test, the plaintiff tried to distinguish *MCA Records* on the grounds that the defendant's video game "is not 'about' the Play Pen the way that [the song] Barbie Girl was about Barbie." *Id.* at 1100. This Court rejected that argument, emphasizing the "low threshold the Game must surmount" on the first prong of the *Rogers* test. *Id.* Because the defendant's work involved the "develop[ment of] a cartoon-style parody of East Los Angeles," the Court held that

a "reasonable way" to do so was to "recreate a critical mass of the businesses and building in that neighborhood. *Id*. at 1100.[50] "In this context, [this Court] conclude[d] that to include a strip club that is similar in look and feel to the Play Pen does indeed have at least 'some artistic relevance.'" *Id.*

The same is true here. EA set out to create a video game in which users would have the ability to simulate the experience of playing NFL football, and to control individual teams' development and performance.[51] In some editions of *Madden NFL*, users had the opportunity to play not only current NFL teams, but also historical teams, including the 1965 Cleveland Browns.[52] As the district court noted, EA's alleged "[u]se of a legendary NFL player's likeness in a game about NFL football is clearly relevant."[53] "Thus, even assuming that all material factual allegations in Brown's complaint are true, and viewing them in the light most favorable to Brown," the district court found that "EA's use of Brown's likeness in

[50] Although this Court described the game as a parody, its analysis did not turn on that characterization.

[51] ER 95-96, 107-114.

[52] ER 96.

[53] ER 8.

the *Madden NFL* games was not completely irrelevant to the games' content."[54] That conclusion was correct and should not be disturbed.

2. By Its Alleged Use Of Brown's Likeness In *Madden NFL*, EA Did Not Explicitly Mislead Consumers Into Believing That Brown Sponsored Or Endorsed The Game.

Brown offers five, uniformly unpersuasive arguments as to why the district court erred in concluding that EA's alleged use of Brown's likeness in the game was not explicitly misleading. First, he cites extensively to an out-of-print, 27-year-old "survey probing public attitudes regarding *licensed wearing apparel bearing a picture of a cartoon character*," which was cited in a section of *McCarthy on Trademarks* entitled "*Protection of Characters Against Use in the Sale of Commercial Products*." Op. Br. at 1, 18, 24, 25, 31, 36, 37, 39, 46, citing 2 McCarthy, § 10:43, at 10-120 (emphases added). Brown asserts that this survey about cartoon characters on t-shirts is part of the "record" and criticizes the district court for "never consider[ing] this point" (Op. Br. at 25), even though he never mentioned the survey below.[55] Contrary to Brown's repeated claim, this survey plainly is not legal "authority" (Op. Br. at 1, 18, 24, 36), is not part of the record, and – most importantly – is irrelevant to the question of whether the First Amendment protects EA's alleged use of Brown's likeness in its video game.

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[54] ER 8.

[55] *See* ER 201-219.

Citing *only* this survey, Brown insists that his "*presence in the game is enough to explicitly mislead*," (Op. Br. at 35), and that "[n]o case in this Circuit (or any other Circuit) has ever held to the contrary (*id.* at 25). In fact, this Court repeatedly and emphatically has rejected this very argument in other Lanham Act cases involving expressive works. In *MCA Records*, for example, this Court noted that "[t]he only indication that Mattel might be associated with the song is the use of Barbie in the title; *if this were enough to satisfy this prong of the Rogers test, it would render Rogers a nullity*." 296 F.3d at 902 (emphasis added). In *E.S.S.*, this Court reiterated that "*the mere use of a trademark alone cannot suffice to make such use explicitly misleading*." 547 F.3d at 1101 (emphasis added). The Court explained that "a trademark infringement claim presupposes a use of the mark. If that necessary element in every trademark case vitiated a First Amendment defense, the First Amendment would provide no defense at all." *Id.* at 1099.[56]

Second, Brown argues that EA explicitly misled consumers through "'game feature' materials" that were found inside an instruction manual that accompanied *Madden NFL 2001* and stated that the game includes "[f]ifty of the NFL's greatest

[56] Brown's heavy reliance on the apparel survey also ignores cases like *ETW*, where the court dismissed Tiger Woods' Lanham Act claim even though surveys showed that a substantial majority of the public believed that Woods had authorized the use of his name and likeness in the defendant's works. 332 F.3d at 930. *See also Rogers*, 875 F.2d at 1002.

players and every All-Madden team." Op. Br. at 6, 37.[57] As a threshold matter, these materials are irrelevant because the only editions of the game at issue in this action are *Madden NFL '06 – Madden NFL '09*. Any claim arising from each annual edition of *Madden NFL* accrued on the date that the edition was published, regardless of when Brown allegedly discovered the purportedly wrongful conduct. *Christoff v. Nestlé USA*, 47 Cal. 4th 468, 474 (2009). *See also* Cal. Civ. Code § 3425.3. While the "Lanham Act contains no explicit statute of limitations," courts "presume that Congress intended to borrow the limitations period from the most closely analogous action under state law." *Jarrow Formulas v. Nutrition Now*, 304 F.3d 829, 836 (9th Cir. 2002). Here, Brown's Lanham Act claim is most analogous to his state-law right-of-publicity claims, and should be subject to a two-year limitations period. *See Spangler v. Abercrombie & Fitch*, 79 Fed. Appx. 325, 326 (9th Cir. 2003) (applying the single-publication rule to common-law and statutory misappropriation and Lanham Act claims); *Yeager v. Bowlin*, 2008 U.S. Dist. LEXIS 70455, at *3 (E.D. Cal. Aug. 5, 2008) (same). Even assuming that the Lanham Act claim were most analogous to Brown's unfair-competition claim under Business and Professions Code Section 17200, the trademark claim would be subject to a four-year statute of limitations. Cal. Bus. &

[57] *Madden NFL 2001* was first released in 2000.

Prof. Code § 17208. Because any claim based on *Madden NFL 2001* would be time-barred, these game-feature materials are irrelevant.[58]

In any event, Brown's argument is a classic syllogism – the game includes 50 of the greatest players; Brown is considered by many to be one of the 50 greatest players; therefore, the game must include Brown. By definition, such a syllogism cannot be *explicitly* misleading. Indeed, if the alleged inclusion of Brown's likeness within the game is insufficient to make EA's use explicitly misleading, *see E.S.S.*, 547 F.3d at 1101, then the mere implication that his likeness appears in the game also is insufficient.

Third, Brown insists that EA's allegedly "ineffective 'scrambling'" of his likeness "demonstrates an attempt to explicitly mislead the public." Op. Br. at 37.

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[58] The game-feature materials that Brown discusses also are irrelevant because they were found on page five of an instruction manual contained inside the game's packaging. *See Rice v. Fox Broadcasting Co.*, 330 F.3d 1170, 1181 (9th Cir. 2003) (holding that the defendant's allegedly misleading "videotape jacket could not be observed by potential consumers, and therefore could not influence the purchasing decision," rendering the alleged false statements on the jacket "immaterial" for trademark purposes). Moreover, when informational or even promotional materials accurately reflect the content of an underlying expressive work, they are entitled to the same First Amendment protection as that work. *See, e.g.*, *Page v. Something Weird Video*, 960 F. Supp. 1438, 1444 (C.D. Cal. 1996) (holding that advertisements of two motion pictures were constitutionally "protected because the videos themselves are protected by the First Amendment, and the advertising is incidental to the protected publication of the videos"); *ETW*, 332 F.3d at 920 (use of the registered mark TIGER WOODS in accompanying marketing materials that merely described a painting that depicted Tiger Woods did not constitute infringement).

This argument is illogical. As the district court observed from viewing the contents of the game, most of the virtual players in the game are *not* scrambled.[59] Indeed, Brown concedes that active NFL players are depicted using "virtually photo-realistic digital animation" (Op. Br. at 6); their likenesses accurately reflect their facial characteristics and their uniforms bear their names and the numbers they wear.[60] In contrast, for the virtual players on the historical teams in the relevant editions of the game, EA did not use their actual names, likenesses, or uniform numbers.[61] As a matter of law and common sense, "scrambling" – which Brown interprets to mean making a virtual Cleveland Browns running back that Brown claims is him *not look like him* – does not even *imply* an endorsement, much less satisfy the "explicitly misleading" standard.[62]

Fourth, Brown contends that EA's alleged statements about the game to "Brown's representatives" and to "the public" create a factual issue about whether

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[59] ER 8. *See also id.* 2.

[60] ER 2. *See also id.* 96.

[61] ER 2. *See also id.* 96.

[62] Brown presumably recognizes the defects in his scrambling argument, but raises it as a means of mentioning *Adderley v. NFLPA*, No. C07-943-WHA, 2009 WL 88484 (N.D. Cal. Jan. 13, 2009). That case, which Brown admits he was not part of, centered on breach-of-fiduciary-duty claims by certain retired NFL players against their union, the NFL Players' Association. EA was not a named party to that lawsuit. *Adderley* is irrelevant to application of the *Rogers* test here.

EA's use of his likeness in the game was explicitly misleading. EA's statements to Brown's representatives that his name and likeness did not appear in recent editions of the game were neither false nor explicitly misleading. As noted above in the discussion of scrambling and as demonstrated by the games that are part of the record, Brown's name and actual likeness did not appear in the relevant editions of the game.[63] Even if his name and likeness were in the games, however, Brown does not (and cannot) explain how statements to "his representatives" could mislead *consumers* about the game's source.

The supposed public statements also fail to demonstrate that EA's alleged use of Brown's likeness was explicitly misleading. In the Opening Brief, Brown mischaracterizes the alleged statements that he attributes to an EA employee who spoke on a panel at a law school. Op. Br. at 38. In his complaint, Brown does not allege that the employee stated that EA had *Brown's* permission to use his likeness. Instead, Brown alleges only that the employee was "asked how [EA] w[as] able to use *the players'* likeness [sic] in the Madden video game[,]" and that the employee responded that EA "ha[s] obtained the authorization of the players" to use their likenesses in the game.[64] This alleged statement is not even implicitly misleading; as Brown admits, EA has permission from the NFL Players' Association to use

[63] ER 8.

[64] ER 18 (emphasis added).

current players' likenesses. Op. Br. at 5, 7. Consequently, these statements do not support Brown's position that the district court erred.

Finally, Brown postulates, without supporting authority, that only "incidental" or "background" uses of a plaintiff's name or likeness in an expressive work are protected. Op. Br. at 29, 31, 32. This Court's authorities do not support that proposition; indeed, Barbie was used much more than just incidentally in the defendants' works in *MCA Records* and *Walking Mountain*. *See MCA Records*, 296 F.2d at 897; *Walking Mountain*, 353 F.3d at 800. And *ETW* completely contradicts Brown's theory. In that case, the court held that the *Rogers* test barred Tiger Woods' Lanham Act claim, even though his likeness indisputably was the focus of the defendant's painting. 332 F.3d at 922. In any event, even assuming Brown's persona were included in *Madden NFL*, that virtual player would be one of thousands of players and other creative elements in the game – and one which a user would never have to see or encounter to enjoy the game. *See E.S.S.*, 547 F.3d at 1102. But even assuming – contrary to what the game actually shows – that Brown's likeness was anything more than an incidental feature, that still would not satisfy the explicitly-misleading standard.

In the end, none of Brown's arguments come close to showing the existence of a factual issue about whether EA's alleged use of his likeness in the game explicitly misleads consumers into believing that Brown sponsored or endorsed the

game. In a variety of other contexts, courts have recognized that "explicitly misleading" requires much more than "[a]mbiguous or implicitly misleading conduct." *In re Kennerley*, 995 F.2d 145, 147-148 (9th Cir. 1993). Instead, "explicitly misleading" means "clearly and actively engag[ing] in a material misdirection[.]" *In re Goscicki*, 207 B.R. 893, 898 (9th Cir. BAP 1997). These authorities are consistent with the ordinary definition of "explicit" as "expressed without vagueness or ambiguity; specific." *Webster's II New College Dictionary* (2001).

Consistent with these definitions, the Second Circuit held in *Rogers* that even consumer "misunderstanding" about whether a celebrity endorsed a work could not satisfy the explicitly-misleading standard, unless it was "engendered by an[] *overt claim*" by the defendant. 875 F.2d at 1000 (emphasis added). Similarly, in *ETW*, the Sixth Circuit emphasized that "[t]he risk" that consumers might "misunderstand" and presume that a celebrity was associated with an expressive work that contained his name or likeness is not remotely sufficient to satisfy the requirement that the use must be "explicitly misleading." 332 F.3d at 937. To overcome the First Amendment, the misunderstanding must have been caused by the defendant's "*explicit indication on the face of the [work*]" of the plaintiff's endorsement or sponsorship. *Id.* (emphasis added).

Here, Brown did not allege any facts showing that EA overtly claimed or explicitly indicated that he sponsored the game. As the district court observed, "it would require a leap of logic to conclude that the anonymous, mis-numbered player's presence in the games equates to Brown's endorsement of the games."[65] Thus, the district court correctly held, based on its review of the content of the game and its packaging, that EA's alleged use of Brown's likeness was not explicitly misleading, and that the First Amendment bars his Lanham Act claim.

D. The District Court Properly Dismissed Brown's Lanham Act Claim At The Pleading Stage.

Brown's final argument is that the district court erred by applying the *Rogers* test at the pleading stage, after reviewing the games in question, because he alleged in his complaint that EA's use of his likeness was explicitly misleading. Op. Br. at 3, 14-15, 17, 26. As the district court recognized, "all material factual allegations in the complaint are assumed to be true [for purposes of a motion to dismiss,] and [are] construed in the light most favorable to the plaintiff."[66] For purposes of the motion, the district court also considered the declarations and exhibits that Brown attached to his opposition "and interpreted [those materials] in

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[65] ER 9; *see also id.* 2.

[66] ER 3, citing *Nursing Home Pension Fund, Local 144 v. Oracle Corp.*, 380 F.3d 1226, 1229 (9th Cir. 2004).

the light most favorable to Brown."[67] But the district court was not required to – and expressly did not – "accept any unreasonable inferences or assume the truth of legal conclusions cast in the form of factual allegations." *Ileto v. Glock*, 349 F.3d 1191, 1200 (9th Cir. 2003).[68]

Under the incorporation-by-reference doctrine, the district court also properly considered the relevant editions of *Madden NFL*. Because Brown's Lanham Act claim "depend[s] on the contents" of EA's game, because EA submitted the relevant editions with its motion to dismiss, and because there was no dispute about the authenticity of those materials, the court properly reviewed the contents of the game and its packaging in connection with the motion. *Knievel*, 393 F.3d at 1076. Brown does not contest the district court's application of the incorporation-by-reference doctrine. Consequently, contrary to Brown's argument (Op. Br. at 3, 14-15, 17), the district court was not required to accept his conclusory allegations that were contradicted by the contents of the game. *Id.*

That rule applies with particular force where, as here, a plaintiff's complaint targets the defendant's exercise of free expression. For example, in *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 596 (9th Cir. 2000), this Court took judicial notice of the defendant's film, which allegedly violated Section 43(a)

[67] ER 8 n.5.

[68] ER 4.

of the Lanham Act by incorporating a short clip of The Three Stooges. Despite the plaintiff's allegation to the contrary, the district court found – and this Court affirmed – that the clip was not a cognizable trademark. *Id.* at 596-598. Likewise, in *Knievel*, the district court applied the incorporation-by-reference doctrine to consider pages from ESPN's website that provided the context in which the allegedly defamatory statement was published. 393 F.3d at 1076. Although the plaintiffs alleged in their complaint that the statement was defamatory, the district court nonetheless found – and this Court affirmed – that the statement was constitutionally protected opinion. *Id.* at 1078.

As these cases make clear, the district court was not obligated to hold that EA's alleged use of Brown's likeness in *Madden NFL* was explicitly misleading just because Brown said so in his complaint. The court properly reviewed the complaint and the contents of the game, and determined that the First Amendment barred Brown's Lanham Act claim as a matter of law.[69] Courts within this Circuit routinely do the same. *See, e.g., Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962, 973 (C.D. Cal. 2007) (granting motion to dismiss Lanham Act and other claims after reviewing television program that formed basis of lawsuit, applying *Rogers* test, and finding that First Amendment barred the plaintiff's claims); *Capcom v. The MKR Group*, 2008 U.S. Dist. LEXIS 83836, at *14-*15

[69] ER 9.

(N.D. Cal. 2008) (same, video game); *Felix the Cat Prods. v. New Line Cinema*, 54 U.S.P.Q.2d 1856, 1858 (C.D. Cal. 2000) (same; motion picture); *Metrano v. Twentieth Century Fox*, Case No. CV 08-6314 PSG (VCKx) (C.D. Cal. July 16, 2009) (same); *Kent v. Universal Studios*, Case No. CV 08-2704 GAF (SHx) (C.D. Cal. Aug. 15, 2008) (same).[70]

This approach is proper, and is essential to protecting free expression. If Brown's argument were adopted, a defendant whose expressive work was targeted by a Lanham Act, right-of-publicity, defamation, or other content-based claim could not assert a First Amendment defense to dispose of a claim at the pleading stage if the plaintiff merely alleged the elements of the claim, even if his conclusory allegations were flatly contradicted by the contents of the defendant's work. That result would defy a long line of cases encouraging the prompt resolution of claims that target speech and would nullify the incorporation-by-reference doctrine.

As the Supreme Court has recognized, "[t]he chilling effect upon the exercise of First Amendment rights may derive from the fact of the prosecution [of a lawsuit], unaffected by the prospects of its success or failure." *Dombrowski v.*

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[70] *Cf. E.S.S. Entertainment 2000 v. Rock Star Videos*, 444 F. Supp. 2d 1012, 1016 n.10 (C.D. Cal. 2005) (declining to apply *Rogers* test on motion to dismiss because defendant failed to provide court with video-game console and controllers for viewing video games at issue in Lanham Act claim).

Pfister, 380 U.S. 479, 487 (1965). Because "the costs of a successful defense can be the same or greater than what the damage awards would have been," *Suzuki Motors Corp. v. Consumers Union*, 330 F.3d 1110, 1142-1143 (9th Cir. 2003), publishers of expressive works "will tend to become self-censors" unless they "are assured freedom from the harassment of lawsuits." *Washington Post Co. v. Keough*, 365 F.2d 965, 968 (D.C. Cir. 1966). Thus, in the analogous context of a state-law right-of-publicity claim against a comic-book publisher, the California Supreme Court reiterated that "because unnecessarily protracted litigation would have a chilling effect upon the exercise of First Amendment rights, speedy disposition of [such] cases … is desirable." *Winter v. DC Comics*, 30 Cal. 4th 881, 892 (2003). Such claims "can often [be] resolve[d] … *as a matter of law* simply by a viewing of the [defendant's] work in question" and applying the appropriate First Amendment test. *Id.* (emphasis added). Indeed, such cases are "often properly resolved on summary judgment or … even on demurrer" (or, presumably, on a motion to dismiss). *Id.*

The district court appropriately did so here. Brown's complaint did not allege either that EA's alleged use of his likeness in the game lacks any artistic relevance, or that its alleged use explicitly misleads consumers into believing that Brown endorsed the game. Moreover, the contents of the game make clear that Brown cannot do so. Under these circumstances, the district court's denial of leave

to amend was proper. As this Court has held, "[w]here the plaintiff has previously filed an amended complaint, … the district court's discretion to deny leave to amend is *particularly broad*." *Miller*, 358 F.3d at 616 (emphasis added; citations and internal quotations omitted). Brown filed his first complaint in New York (which he dismissed after receiving a Rule 11 letter and draft Rule 12(b)(6) motion), his second complaint here (which was dismissed with leave to amend), and finally a third, amended complaint.[71] The district court appropriately exercised its discretion to deny him a fourth opportunity to fashion a claim.[72]

8.

CONCLUSION

Brown proposes that this Court fundamentally alter the relationship between the First Amendment and trademark law. He urges this Court to disavow its holdings in *MCA Records*, *Walking Mountain*, and *E.S.S.* (Op. Br. at 41-46), to treat *any* use of a mark in an expressive work as a "taking of property without due

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[71] ER 135-150, 11-26; SER 7-20.

[72] After dismissing Brown's Lanham Act claim, the district court was faced with only the remaining state-law claims. Rather than dismiss those claims on First Amendment grounds, as the court did in *E.S.S.*, 547 F.3d at 1101, the district court declined to exercise supplemental jurisdiction. Because the dismissal of the Lanham Act claim was proper, the court had the discretion to dismiss the remaining state-law claims for lack of jurisdiction. 28 U.S.C. § 1367(a); *Herman Family Revocable Trust v. Teddy Bear*, 254 F.3d 802, 805 (9th Cir. 2001). As set forth in EA's motion to dismiss, Brown's state-law claims also are barred as a matter of law. ER 39-55.

process of law" (*id.* at 23), and to adopt the extreme position that any interference with a trademark owner's rights may be exercised only "*by the state*, after appropriate administrative, legislative or judicial proceedings." *Id.* at 24 (emphasis added). If his arguments were accepted, a broad range of expressive works might be subject to Lanham Act claims: not only *Madden NFL*, but also films like *Forrest Gump*, *Finding Neverland*, and *Social Media*; songs like *Buddy Holly*, *American Pie*, and *Bette Davis Eyes*; and novels like James Ellroy's *L.A. Confidential*, E.L. Doctorow's *Ragtime*, and Don DeLillo's *Libra*.

This Court should decline Brown's invitation to transform trademark law, whose "core purpose [is] to avoid confusion in the marketplace," *MCA Records*, 296 F.2d at 897, into a weapon for prominent individuals to restrain the use of their names or likenesses in expressive works. When such works are targeted by Lanham Act claims, this Court has recognized that the use of a celebrity's name or likeness is protected "unless the [use of the mark] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless [it] explicitly misleads as to the source or the content of the work." *E.S.S.*, 547 F.3d at 1098, quoting *MCA Records*, 296 F.3d at 902 (internal citation omitted).

EA's alleged use of Brown's likeness within its expressive work about NFL football unquestionably has the required "above zero" artistic relevance. *See E.S.S.*, 547 F.3d at 1100. And Brown has not (and, after three attempts at stating a

claim, plainly cannot) allege any facts to establish that EA's alleged use of his likeness explicitly misleads the public into believing that he endorses or sponsors *Madden NFL*. Accordingly, EA respectfully requests that this Court affirm the district court's decision dismissing Brown's Lanham Act claim without leave to amend and dismissing the state-law claims for lack of jurisdiction.

RESPECTFULLY SUBMITTED this 20th day of September, 2010,

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CERTIFICATE OF COMPLIANCE

Pursuant to Rule 32(a)(7)(C) of the Federal Rules of Appellate Procedure and Ninth Circuit Rule 32-1, I certify that the attached Appellee's Answering Brief is proportionately spaced in 14-point Times New Roman typeface and contains 10,428 words (as calculated by Microsoft Word 2003), excluding the Excerpts of Record, Corporate Disclosure Statement, Statement of Related Case, Addendum of Pertinent Constitutional Provisions and Statutes, and this Certificate of Compliance.

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STATEMENT OF RELATED CASES

On April 30, 2010, this Court ordered that this appeal "will be assigned to the same panel, if practicable" as the appeal in *Keller v. Electronic Arts, Inc.* (No. 10-15387). SER 1.

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ADDENDUM OF PERTINENT CONSTITUTIONAL PROVISIONS AND STATUTES

First Amendment to the United States Constitution

Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.

15 U.S.C. § 1125(a)

False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which--

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.